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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,397	01/14/2004	Sharon Cohen-Vered	2609/68811-A/JPW/GJG/JBC	6066
7590	06/01/2006		EXAMINER	
Cooper & Dunham LLP 1185 Avenue of the Americas New York, NY 10036			AUDET, MAURY A	
			ART UNIT	PAPER NUMBER
			1654	

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Applicant(s)</b>	<b>Applicant(s)</b>	
	10/758,397	COHEN-VERED ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Maury Audet	1654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**P r i d f r Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disp sition of Claims**

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-47 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction is required under 35 U.S.C. 121.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept.

In accordance with 37 CFR 1.142 applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

- I. Claims 1-13, 15, 24-26, 37, 48-52, drawn to a composition comprising a peptide comprising 12-30 consecutive amino acids having a myriad of distinct amino acid sequences (e.g. SEQ ID NO: 8 of FSGYYWS versus SEQ ID NO: 9 of EINHSGSTNYKTSLSKS); classified in class 530, subclass 300+.
- II. Claim 14, drawn to a method of treating systemic lupus erythematosus (SLE), using a composition comprising a peptide comprising 12-30 consecutive amino acids having a myriad of distinct amino acid sequences (e.g. SEQ ID NO: 8 of FSGYYWS versus SEQ ID NO: 9 of EINHSGSTNYKTSLSKS); classified in class 514, subclass 2.
- III. Claims 16-23, drawn to a method of making a composition comprising a peptide comprising 12-30 consecutive amino acids having a myriad of distinct amino acid sequences (e.g. SEQ ID NO: 8 of FSGYYWS versus SEQ ID NO: 9 of EINHSGSTNYKTSLSKS); classified in class 424, subclass 1.69+.
- IV. Claims 27-47, drawn to a method of lyophilizing a composition comprising a peptide comprising 12-30 consecutive amino acids having a myriad of distinct amino acid sequences (e.g. SEQ ID NO: 8 of FSGYYWS versus SEQ ID NO: 9 of EINHSGSTNYKTSLSKS),

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comprising lowering the temperature to -40 or -45 degrees Celcius and raising the temperature to 20 or 25 degrees Celcius (and various time ranges thereto); classified in class 424, subclass 1.69+.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the process for using the product as claimed can be practiced with another materially different product, namely a composition comprising a peptide comprising 12-30 consecutive amino acids having a myriad of distinct amino acid sequences (e.g. SEQ ID NO: 8 of FSGYYWS versus SEQ ID NO: 9 of EINHSGSTNYKTSLSKS).

Inventions I and III-IV are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed can be used to make another and materially different product, namely any composition comprising a peptide comprising 12-30 consecutive amino acids having a myriad of distinct amino acid sequences (e.g. SEQ ID NO: 8 of FSGYYWS versus SEQ ID NO: 9 of EINHSGSTNYKTSLSKS).

Inventions II and IV are directed to different methods of use, which are not connected in design, operation, and/or effect. These methods are independent since they are not disclosed as

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capable of use together, they have different modes of operation, they have different functions, and/or they have different effects. One would not have to practice the various methods at the same time to practice just one method alone.

The several inventions above are independent and distinct, each from the other. They have acquired a separate status in the art as a separate subject for inventive effect and require independent searches. The search for each of the above inventions is not co-extensive particularly with regard to the literature search. Further, a reference, which would anticipate the invention of one group, would not necessarily anticipate or even make obvious another group. Finally, the consideration for patentability is different in each case. Thus, it would be an undue burden to examine all of the above inventions in one application. Restriction for examination purposes is therefore proper.

Because these inventions are distinct for the reasons given above and the search required for each group is not necessarily required for the other groups, restriction for examination purposes as indicated is proper.

#### ***Requirement for Peptide Election***

The inventions of Groups I-IV are drawn to or use of any composition comprising a peptide comprising 12-30 consecutive amino acids having a myriad of distinct amino acid sequences (e.g. SEQ ID NO: 8 of FSGYYWS versus SEQ ID NO: 9 of EINHSGSTNYKTSLKS). There is no substantial core structure that runs through the myriad of embodiments that can represent the peptides within the myriad of compositions. Therefore,

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irrespective of which Group (Groups I-IV) is elected as the invention, Applicant must elect a single, distinct, peptide (e.g. SEQ ID NO: 8 of FSGYYWS), as the peptide within the composition. Due to the myriad of distinct, independent peptides/compositions containing, a search of more than one peptide/compositions thereto would constitute an undue search burden. **This requirement is not to be taken as an election of species, but rather as an election of a single invention, since each compound is assumed to be a patentably distinct invention, in the absence of evidence to the contrary.**

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***In re Ochiai/Brouwer Rejoinder***

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier.** Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of

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35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

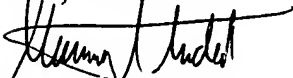
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maury Audet whose telephone number is 571-272-0960. The examiner can normally be reached on M-Th. 7AM-5:30PM (10 Hrs.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecelia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MA, 05/28/2006



MAURY AUDET  
PATENT EXAMINER  
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